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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,702	12/17/2003	Thomas Grafenauer	03100137US	5695

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EXAMINER	
CAJILIG, CHRISTINE T	

ART UNIT	PAPER NUMBER
3637	

NOTIFICATION DATE	DELIVERY MODE
07/25/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Advisory Action Before the Filing of an Appeal Brief	Application No. 10/736,702	Applicant(s) GRAFENAUER, THOMAS	
	Examiner Christine T. Cajilig	Art Unit 3637	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Note for box item 3 in the attached sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): Drawing objection.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1-20.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Note for box item 11 in the attached sheet.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/CTC/

Note for box item 3

The proposed amendment to claims 1 and 8 raises new issues for consideration and possible further search. By adding limitations, which may have been presented within each of claims 2 and 11 into claims 1 and 8 respectively, presents an entirely new claim for consideration on the merits with the language of claims 1 and 8 as proposed in the amendment never having been considered with respect to the claims dependent on the amended claims.

Note for box item 11

In response to Applicant's argument for claim 18 rejected under 35 U.S.C. 112, 2nd paragraph:

Applicant's response to the 35 U.S.C., 2nd paragraph rejection on claim 18 does not address the issue posed in the Final Office Action dated December 7, 2006 of whether Applicant's invention, as claimed in claim 18, "is directed to a floor board [i.e. building board] per se, or to the floor board [i.e. building board] and the beams to which the markings would correspond." Claim 18 appears to define the building board with respect to the beams to which the markings would correspond and therefore it still remains unclear whether Applicant is claiming only the building board per se, or the building board along with beams to which the markings on the building board would correspond.

In response to Applicant's argument for claim 8 rejected under 35 U.S.C. 102(b) as anticipated by Palsson:

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Amended claim 8 was previously claim 8 rewritten to include the features of claim 11. Claim 8 was originally rejected under 35 U.S.C. 102(b). Claim 11 was rejected under 35 U.S.C. 103(a) and not 35 U.S.C. 102(b). Thus, although Palsson does not anticipate amended claim 8, amended claim 8 is nonetheless unpatentable under 35 U.S.C. 103(a).

In response to Applicant's argument for claims 1, 2, and 11 rejected under 35 U.S.C. 103(a) as unpatentable over Palsson in view of Olofsson:

Applicant argues, "Palsson does not disclose a tongue having a convex underside and a bevel" and that the "element 'a' [of Palsson] does not constitute a bevel, as recited in the claimed invention, because it exhibits a wavy (i.e., not flat or planar) contour." Furthermore, Applicant defines the term bevel as "'the inclination that one line or *surface* makes with another when note at right angles,' or 'a surface that does not form a right angle with adjacent surface.'" (emphasis added). Even by Applicant's own definitions, the term bevel does not require a flat or planar contour. Further element "a" of Palsson, as annotated in Palsson, fits the definition of a bevel as offered by Applicant. While Applicant's drawings may show a bevel "b" including flat or planar surface, such limitations are not recited in the claim. For all of these reasons, element "a," although not flat or planar is nevertheless a bevel.

Applicant further argues, "Olofsson does not disclose a recess adjacent to a bevel." First, the recess in Olofsson may include the entire region extending before the right side of "a" and the left most edge of the top planar surface. Thus Olofsson

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discloses a recess adjacent a bevel "3". Alternatively, Olofsson discloses a recess "6" adjacent a bevel "3." Further, Palsson already discloses the bevel "a," while Olofsson teaches a recess "6." Modifying Palsson to include recess "6" of Olofsson would place recess "6" adjacent to the bevel "a" of Palsson, thus reading on the claimed limitations.

In response to Applicant's argument for claims 12-14 and 20 rejected under 35 U.S.C. 103(a) as unpatentable over Palsson in view of Hall:

Applicant argues "Hall does not compensate for the deficiencies of Palsson with respect to claim 20 because Hall does not disclose a plurality of spaced apart depressions in a bottom lip that bounds a groove." Applicant further argues "Hall's flange B is not a bottom lip that bounds a groove that corresponds to a tongue." Furthermore, Applicant states that Hall has a "lip or flange portion B" and that the "flange B comprises holes c for screws or nails." Hall indeed discloses a bottom lip "B" with a plurality of spaced apart depressions "c" since a lip and a flange are not mutually exclusive. Moreover, modifying Palsson to include a plurality of spaced apart depressions "c" as taught by Hall would place the spaced apart depressions in the bottom lip of Palsson that bounds a groove, thus reading on the claimed limitations.

Information Disclosure Statement

The information disclosure statement filed 10/11/06 fails to fully comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because: on line item 7 on page 1 (US 6775545) and on line item 1 on page 19 (20020106680), the patent number or

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publication number listed does not correspond to the name of the inventor nor the date published. It has been placed in the application file, but the non-complying information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Drawings

Applicant's arguments, see pages 8-11 of Remarks, filed 7/12/07, with respect to the drawing objection has been fully considered and are persuasive. The drawing objection has been withdrawn.

/CTC/
7/19/07

LANNA MAI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

